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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,880	11/13/2003	Steven M. Reinecke	068612.0220	1109
5073	7590	11/16/2004		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER DOSTER GREENE, DINNATIA JO	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,880	REINECKE ET AL.	
	Examiner	Art Unit	
	Dinnatia Doster-Greene	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002 and 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10 is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detail Action</u> . |

DETAILED ACTION

Election/Restrictions

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-10, drawn to a brace with an integrated lumbar support system, classified in class 602, subclass 13.

II. Claims 11-19, drawn to a method for fitting a user for a brace with an integrated lumbar support system, classified in class 2, subclass 467.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process can be used to make other and materially different products such as a brace wherein the lumbar and the pump are not coupled to the belt.

3. Because these inventions are distinct for the reasons given above and has acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, therefore, restriction for examination purposes as indicated is proper.

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4. Through telephonic communication with Bill McFadden on November 11, 2004 a provisional election was made with traverse to prosecute the invention of **Group I, claims 1-10**. Applicant in replying to this Office Action must make affirmation of this election. **Claims 11-19 are withdrawn** from further consideration by the examiner, 37 C.F.R. 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The Office recognizes that the documents listed on the information disclosure statements filed on November 13, 2003 were filed in U.S. Patent Application 10/407,052. Although the previous Examiner acknowledged these documents, these documents were not scanned into the present application. Therefore, the Office is respectfully requesting that Applicant supply a courtesy copy of the documents which have not be considered in order to expedite the prosecution of this application.

Regarding the information disclosure statement filed on August 17, 2004, this information disclosure statement fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim (U.S. Patent No. Re 34,883).

As to claim 1, Grim discloses in Figs. 1,13, 14,15, 16 a belt positioned about a user's lower torso and the belt comprising a tube at least partially within the belt. An inflatable lumbar pad is shown coupled to the belt for example in Figs. 7 and 8. Grim further discloses a pump coupled to the belt adapted to provide air to the lumbar pad through the tube at least partially integrated within the belt (Figs. 13-14). Specifically, in column 6, lines 64-66 discloses that a small flexible hand pump may be kept assembled with the back support of Grim.

As to claim 3, Grim discloses a coupling 136 (Figs. 8 and 9). The coupling 136 attaches over tube 134 as the tube extends into the bladder 26. Grim states in column 6, lines 50, "To operatively connect the outlet 32 to the respective chamber 26, a tube 134 may be fitted over the outlet 32 and coupled to a fitting 136 mounted through either the first wall 126 or second wall of the bladder 26 to communicate with the respective one of the first chamber 118, second chamber 120 or third chamber 124." Therefore, the first portion of the tube 134

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in Grim is coupled from the pump and the coupling 136 and the second portion is coupled from the lumbar pad and the coupling 136.

As to claim 4, the coupling comprises a hollow fitting.

As to claim 5, the tube 134 is capable of being cut. For instance, during the manufacturing process the tube 134 is cut depending upon the size of the belt which is being manufactured—whether the belt will be sold to a user who wears a small, medium or large size. Therefore, the Office has taken the position that the tube 134 of Grim is “adaptable” to being cut substantially simultaneously with the belt being cut to a length to be positioned about the user’s lower torso.

As to claim 6, Grim discloses a release valve 132 or 232 coupled to the pump (Figs. 1 and 13).

As to claim 7, Grim discloses a backplate (Figs. 14, stays 232).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (Re. 34,883) in view of Grim et al. (U.S. Patent No. 5,695,452). Grim (Re. 34,883) discloses the claimed invention with the exception of a specific recitation that the belt comprises a rigid portion and a resilient portion. Grim '452, which also relates to a brace having a lumbar pad (Figs. 11-18 and 25), teaches that compression molding can be used to vary the thickness and density of the material in selected areas of a brace for the purpose of improving the function of the brace. Grim '542, in column 3, lines 53-67, specifically teaches that a brace can be made of both resilient and rigid portions. Thus, it would have been obvious to one skilled in the art to modify the brace of Grim (Re. 34,883) with the teaching of Grim '542 for the purpose of improving the function of the back support.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (Re. 34,883) in view of Lelli et al. (U.S. Patent No. 5,363,863).

Grim discloses the claimed invention as discussed above with the exception of a back plate coupled to the belt using a canting mechanism. Lelli, like Grim in Figs. 8 and 9, discloses a lumbar support belt having two attachment belts extending from each side of a back plate. Lelli further discloses length adjustment means (4a) attached to the back plate. Thus, it would have been obvious to one skilled in the art at the time of the invention to substitute the

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attachment belts (108) of Grim with the length attachment means (4a) for the purpose of adjusting the belt to conform to the user's body.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunfee (U.S. Patent No. 5,950,628) in view of Ousdal (U.S. Patent No. 5,916,188).

Dunfee discloses a belt adapted to be positioned about a lower torso, a lumbar pad 156 and a pump 65 (Fig. 8) coupled to the belt for providing air to the lumbar pad. Dunfee also discloses an upper belt (20) and lower belt (30) configuration and one or more supports (40) coupled between the upper and lower belts. Thus, Dunfee discloses the claimed invention with the exception of a piston slidably engaged within a housing and a motion limiter. Ousdal, like Dunfee, discloses a back supporting device having an upper and lower belt. Ousdal further discloses pistons (5, 6) positioned at either side of the back supporting device and connected to the upper and lower belts in order to reduce a patient's back pain by stretching out the patient's spine. Thus, it would have been obvious to one skilled in the art at the time of the invention to incorporate the pistons (5, 6) into the back supporting device of Dunfee for the purpose of alleviating a patient's back pain.

Allowable Subject Matter

12. Claim 10 is allowed.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pekar et al. (U.S. Patent No. 5,437,615); Curlee (U.S.

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Patent No. 4,682,587); Zablotzky et al. (U.S. Patent No. 5,450,858); Gilmour et al. (U.S. Patent No. 6,364,186); Ordway (U.S. Patent No. 6,331,170); Hill (U.S. Patent No. 5,195,948); and Curlee (4,178,922).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinnatia Doster-Greene whose telephone number is 703-308-1041. The examiner can normally be reached on 8:30-4:30.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ddg

Henry Bennett
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